REMARKS/ARGUMENTS

Summary of the Examiner's Actions

The examiner indicated that two of the references cited in the Information Disclosure Statement (IDS) were not considered as the date of publication was not provided. The examiner advised applicants to provide the publication date of each.

The examiner rejected Claims 1-10 and 12-25 under 35 U.S.C. § 103(a). Specifically, the examiner rejected claims 1-3, 7-10, 12 and 14-16 as being unpatentable over U. S. Patent No. 6,245,184 ("the '184 patent"), issued to Riedner *et al.*, in view of U. S. Patent No. 5,091,650 ("the '650 patent"), issued to Uchida *et al.* Claims 4-6 and 17-25 were rejected as being unpatentable over the '184 patent in view of the '650 patent, and further in view of U. S. Patent No. 4,879,465 ("the '465 patent"), issued to Persyk *et al.* Applicants acknowledge the rejection under 35 U.S.C. § 103(a).

Finally, the examiner rejected Claims 1-25 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-20 of U. S. Patent No. 6,749,761. Applicants acknowledge such rejection.

Rejections under 35 U.S.C. § 103(a)

In order to support a rejection under 35 U.S.C. § 103(a), "the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP § 2142, pg. 2100-121, 8th ed. "To reach a proper determination under 35 U.S.C. § 103(a), the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." *Id.* The first element in establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143, pg. 2100-122, 8th ed. The second element is that there "must be a reasonable expectation of success." *Id.* The third element is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.*

The relevant facts for finding obviousness relate to (1) the scope and content of the prior art, (2) the level of ordinary skill in the field of the invention, (3) the differences between the claimed invention and the prior art, and (4) any objective evidence of nonobviousness such as long felt need, commercial success, the failure of others, or copying. *Graham v. John Deere Co.*, 148 U.S.P.Q. 459, 467 (1966; *see Continental Can Co. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1750-51 (Fed. Cir. 1991). The Supreme Court in *Graham* stated that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467. The *Graham* court further stated that "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." *Id.*

The examiner rejected Claims 1-10 and 12-25 under 35 U.S.C. § 103(a). Specifically, the examiner rejected claims 1-3, 7-10, 12 and 14-16 as being unpatentable over U. S. Patent No. 6,245,184 ("the '184 patent"), issued to Riedner *et al.*, in view of U. S. Patent No. 5,091,650 ("the '650 patent"), issued to Uchida *et al.* Claims 4-6 and 17-25 were rejected as being unpatentable over the '184 patent in view of the '650 patent, and further in view of U. S. Patent No. 4,879,465 ("the '465 patent"), issued to Persyk *et al.* Applicants acknowledge the rejection under 35 U.S.C. § 103(a).

It is assumed from examiner's comments regarding these rejections that the intent was to cite U. S. Letters Patent No. 6,236,710 issued to Wittry, and not the '650 patent cited above. Applicants' response is prepared with this assumption, and applicants would appreciate clarification on this citation.

As discussed below, the examiner further rejected Claims 1-25 under the judicially-created doctrine of obviousness-type double patenting. Applicants have filed herewith a terminal disclaimer in order to overcome such rejection. In view of the terminal disclaimer, and for reason set forth below, it is respectfully requested that the examiner's rejections under 35 U.S.C. § 103(a) be withdrawn.

Rejection under Judicially-Created Doctrine of Obviousness-Type Double Patenting

The examiner rejected Claims 1-25 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-20 of U. S. Patent No. 6,749,761 ("the '761 patent"). The examiner indicated that although the conflicting claims are not identical, they are not patentably distinct from each other. As such, it is respectfully submitted that the claims are now in condition for allowance.

As indicated by the examiner, a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. As discussed above, enclosed herewith is a Terminal Disclaimer as required. Accordingly, it is respectfully submitted that the examiner's rejection under the judicially-created doctrine of obviousness-type double patenting has been overcome.

It is respectfully submitted that because the Terminal Disclaimer serves to overcome the double patenting rejection, the examiner's rejections under 35 U.S.C. § 103(a) have likewise been overcome. To wit, in the examination of the application leading to the '761 patent, the examiner issued a Notice of Allowability in response to the patent application as filed. In allowing the claims, the examiner cited several references as pertinent to the disclosure, including the '184 and '465 references cited by the instant examiner. The instant examiner has further cited the '710 patent issued to Wittry for the purpose of making obvious the step of etching or polishing. However, it is admitted that polishing or etching the crystals is not novel to this invention, but is merely an intermediary step in accomplishing the novel high resolution detector array.

Summary

In view of the Terminal Disclaimer, and the arguments presented herein, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the examiner is respectfully requested. If, however, the examiner is of the opinion that any of the drawings or other portions of

the application are still not allowable, it will be appreciated if the examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

Respectfully submitted,

PITTS AND BRITTIAN, P.C.

By _____
Jeffrey N. Cutler
Reg. No. 35,486

PITTS AND BRITTIAN, P.C.
P.O. Box 51295
Knoxville, Tennessee 37950-1295
(865) 584-0105 Voice
(865) 584-0104 Fax